



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

an

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,551	08/09/2001	Peter M. Bonutti	BON-3188-3	7485

33771 7590 01/30/2004

PAUL D. BIANCO: FLEIT, KAIN, GIBBONS,
GUTMAN, BONGINI, & BIANCO P.L.
601 BRICKELL KEY DRIVE, SUITE 404
MIAMI, FL 33131

EXAMINER

BUI, VY Q

ART UNIT PAPER NUMBER

3731

DATE MAILED: 01/30/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,551

Applicant(s)

BONUTTI, PETER M.

Examiner

Vy Q. Bui

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) 1-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-75, 77-95, 97-108 is/are rejected.
- 7) ☐ Claim(s) 76 and 96 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the restriction requirement in Paper No. 8 is acknowledged. The traversal is on the ground(s) that a search including class 623/16.11 for inventions III and IV are not proper because an implant anchor of a bone or a tissue placed in a patient body is not an artificial part for assisting a defective natural body member (Remarks, page 2, paragraph 2). This is not found persuasive because an anchor of freeze-dried bone or freeze-dried tissue is indeed an artificial part of a biological material implanted into a patient for assisting a defective body member. Further, the independent claims of the inventions cover distinct inventions suitable for separate patents even though they are in the same class 606/232. Because the number of inventions/independent claims and the scopes of the inventions cover different art areas, a search and an examination to cover all inventions and claims presented in the present application would be a serious burden for the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

As pointed out by the Attorney, invention V should have been classified in 606/232 instead of 623/232. The examiner would like to thank the Applicant's Attorney for pointing out the typo error in the previous "Office Action".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

At least claims 71, 77-79, 91, 98-99, 104-105 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 19, 33, 106 and 118 of U.S. Pat. No. 5,989,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same main subject matter of the inventions claimed by both the present invention and U.S. Pat. 5,989,282.

Art Unit: 3731

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 71-75, 79-80, 82-85, 87-92, 94-95, 99-100, 102-105, 107-108 are rejected under 35 U.S.C. 102(e) as being anticipated by McGuire (5,865,834).

McGuire (Figs. 1, 4a-4b, 5-6; col. 9, ll. 60-64) discloses autogenous bone or freeze-dried bone anchor/plug 25, suture 27, cutting tool 33 to cut out the autogenous bone plug 25, elongate member/drill to form passages for suture 27 in bone plug 25. Allograft bone plug can be provided from a freeze-drying process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3731

Claims 77-78, 81, 86, 93, 97-98, 101, 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire (5,865,834).

As to claims 77, 97, McGuire discloses substantially every limitation, including a freeze-dried bone anchor 25, as recited in the claims, except for the freeze-dried bone is a cartilage. Cartilage is one well-known type of bone, it would have been obvious to one of ordinary skill in the art to substitute cartilage for a bone tissue because cartilage is just another type of bone.

As to claims 78, 98, McGuire discloses substantially every limitation, including a freeze-dried tissue as bone anchor 25, as recited in the claims, except for the freeze-dried tissue is a tendon. Tendon is well known for high mechanical strength suitable for anchoring different body components one to another. It would have been obvious to one of ordinary skill in the art to make an anchor member from a freeze-dried tendon tissue for this configuration would provide an anchor member mechanically strong to anchor different body components together.

As to claims 81, 86, 93, 101, 106, McGuire discloses substantially every limitation, including a freeze-dried tissue as bone anchor 25, as recited in the claims, except for a process of squeezing water from a sheet of freeze-dried body tissue. Pressing a tissue to squeeze water from the tissue is well known process. It would have been obvious to one of ordinary skill in the art to dry a tissue by the mechanical squeezing process as recited in the claims.

Art Unit: 3731

Allowable Subject Matter

Claims 76, 96 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



VQB
01/22/2004.